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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,867	08/20/2003	Un-Jin Choi	1293.1859	5192

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EXAMINER
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KLIMOWICZ, WILLIAM JOSEPH

ART UNIT	PAPER NUMBER
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2627

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/04/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/643,867

Applicant(s)

CHOI, UN-JIN

Examiner

William J. Klimowicz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 28, 2006 has been entered.

### ***Claim Status***

Claims 1-25 are currently pending.

No Claims have been withdrawn or cancelled.

### ***Specification***

The disclosure is objected to because of the following informalities:

With regard to page 4, line 7 of paragraph [0017], the phrase "optical disc D as shown in FIG. 3" should be changed to the phrase -- optical disc D as shown in FIG. 1. -- since there is no optical disc depicted in FIG. 3..

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More concretely, with regard to independent claims 1 and 11, the phrase “a penetration having a substantially similar shape as the protrusion” (claim 1) and the phrase “the protruding space having a substantially similar shape as the penetration” (claim 11) are both vague and ambiguous. in light of the scope of coverage sought to be protected by Applicant, based on Applicant’s disclosure as a whole. More concretely, the specification does not define the metes and bounds, of what constitutes “a substantially similar shape” Does this means the shape must have two sides which are congruent; tree sides congruent? A congruent volume?

The word “substantially” has more than one distinct connotation, but one accepted meaning is “being largely but not wholly that which is specified.” Webster’s Ninth New Collegiate Dictionary, 1990. As such, “substantially” often finds use as a broadening term in claim drafting. Applicant does not point to anything in the specification that the invention defines such a term. Applicant does not point to anything in the specification that sets forth any range, narrow or otherwise, with respect to what may be considered “substantially similar shape” as the term is used within the scope of the claims.

Does the phrase “the protruding space having a substantially similar shape as the penetration” in fact, require that a three dimensional protruding space fit within a volume that has been removed which forms the penetration, such that if the penetration wasn’t formed in the lower case, the protrusion would occupy as least some three dimensional space of the protrusion when the deck resides within the optical disc drive?

As noted in the MPEP 2173, the claims must particularly point out and distinctly claim the invention. “The primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the *public is informed of the boundaries of what constitutes infringement of the patent.*” *Id.* Emphasis added.

Additionally, since claims 2-10 and 12-25 depend directly or indirectly from claims 1 and 11, respectively, they too are thus rejected under the second paragraph of 35 U.S.C. § 112.

#### ***Allowable Subject Matter***

The Examiner suggest the following claim language, that would be favorably considered, if added to the independent claims, and that would obviate the 112 2<sup>nd</sup> paragraph rejection by providing broad scope coverage, while simultaneously informing the public of the metes and bounds of claim coverage:

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...the penetration formed by omitting and/or removing a portion of the lower case, the protruding space having a substantially similar shape as the penetration such that a two and/or three dimensional protruding space fits within a plane and/or volume that has been removed which forms the penetration, such that if the penetration wasn't formed in the lower case, the protrusion would occupy as least a portion of the two dimensional and/or three dimensional plane and/or space of the protrusion when the deck resides within the optical disc drive.

### *Conclusion*

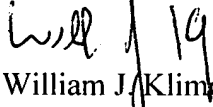
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Klimowicz whose telephone number is (571) 272-7577. The examiner can normally be reached on Monday-Thursday (6:30AM-5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Thi Nguyen can be reached on (571) 272-7579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
William J. Klimowicz  
Primary Examiner  
Art Unit 2627

WJK